UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,704	01/19/2005	Balthasar Antonius Gerardus Van Luijt	2167.023US1	2624

21186 7590 09/28/2009

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
P.O. BOX 2938
MINNEAPOLIS, MN 55402

EXAMINER	
JOO, JOSHUA	

ART UNIT	PAPER NUMBER
2454	

NOTIFICATION DATE	DELIVERY MODE
09/28/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

uspto@slwip.com
request@slwip.com

Office Action Summary	Application No.	Applicant(s)	
	10/521,704	VAN LUIJT ET AL.	
	Examiner	Art Unit	
	JOSHUA JOO	2454	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 June 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3,7-9,11 and 14-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3,7-9,11 and 14-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *17 February 2009* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *3/13/09*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Detailed Action

This Office action is in response to Applicant's communication filed on 06/04/2009.

Claims 1, 3, 7-9, 11, 14-17 are pending for examination.

Response to Arguments

Applicant's arguments with respect to claims 1, 3, 7-9, 11, 14-17 have been considered but are moot in view of the new ground(s) of rejection. New ground(s) of rejection are necessitated by Applicant's amendment. Applicant also argued that:

(1) Since the specification discloses hardware, the Applicant's submit that the Office's premise, i.e. "means for" performing functions to software means, is false and amended claims 3 and 14 overcome the Office's 101 rejection.

In response, although Applicant's specification recites that "some or all parts of the client 101 are implemented as hardware modules", the specification does not specifically disclose that the hardware modules correspond to the modules implementing the "means for" in claim 3 and the claimed modules in claim 14 are implemented as hardware. The specification does not specify which parts of the client 101 are implemented as hardware and thus the hardware modules may be considered as modules other than the claimed modules. The claims themselves also do not comprise the hardware modules to define the device as a hardware device.

(2) The cited references alone or in combination fail to describe "the user profile information including browsing behavior of the user to identify a multimedia interest of the user".

In response, regarding claim 1, Applicant has added the phrase "using the device to perform at least a portion of one or more of the following acts". With the addition of "one or more", alternative

language, the claim does not require the feature of "the user profile information including browsing behavior of the user to identify a multimedia interest of the user".

Drawings

Drawings filed on 02/17/2009 are accepted.

Information Disclosure Statement

The information disclosure statement (IDS) submitted 03/13/2009 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the IDS is being considered by the Examiner.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 3, 7-9, 14-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claim 3, Applicant is seeking to patent a device comprising of "means for" for performing functions. The device does not comprise functional hardware, and according to Applicant's specification, Applicant intends for the "means for" to comprise software means (See Page 4, lines 4-7; page 6, lines 13-15, 27-29). Therefore, the claimed device may be reasonably considered as a software device, and a software device does not meet one of the four categories of invention and is not statutory. Specifically, software is not a series of steps or acts and thus is not a process. Software is not a physical article or object and as such is not a machine or manufacture. Software is not a combination of substances and therefore not a composition of matter.

Regarding claim 13, Applicant is seeking to patent a device comprising only modules. The

device does not comprise functional hardware, and according to Applicant's specification, the claimed modules are software (Also see specification page 4, lines 4-7; page 6, lines 13-15, 27-29). Therefore, the claimed device may be reasonably considered as a software device, and a software device does not meet one of the four categories of invention and is not statutory. Specifically, software is not a series of steps or acts and thus is not a process. Software is not a physical article or object and as such is not a machine or manufacture. Software is not a combination of substances and therefore not a composition of matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Levy et al. US Publication #2007/0294173 (Levy hereinafter).

As per claim 1, Levy teaches the invention as claimed including a method of regulating sharing of a multimedia object file by a device, the method comprising:

using the device to perform at least a portion of one or more of the following acts:

registering usage information for the multimedia object file upon sharing the multimedia object file (Paragraphs 0057; 0061. Register usage. Paragraph 0011. Usage includes copying and distributing of content. Paragraph 0003. Content may include multimedia content.);

transmitting the registered usage information to allow billing of a user of the device for an amount in accordance with the registered usage information for the multimedia object file (Paragraph 0057; 0061. Report usage for billing.);

recording a user profile information for the user, the user profile information including browsing behavior of the user to identify a multimedia interest of the user; and

transmitting the recorded user profile information to allow crediting of a bill for the amount with a sum, upon receipt of the recorded user profile information and the registered usage information.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 3, 8, 11, 14, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levy, in view of Levy, US Publication #2002/0052885 (Levy '2002/0052885 hereinafter) and Ishibashi, US Patent #7,353,541 (Ishibashi hereinafter), and Horvitz et al. US Publication #2004/0076936 (Horvitz hereinafter).

As per claim 3, Levy teaches substantially the invention as claimed including a device arranged for sharing of a multimedia object, comprising:

file sharing means for sharing the multimedia object file with other devices (Paragraphs 0011; 0057. Usage of content includes copying and distributing of content. Paragraph 0003. Content may include multimedia content);

identifying means for obtaining an identifier for the multimedia object file being shared (Paragraph 0057; 0062. Identify unique ID. Paragraph 0052. Unique ID may be a digital watermark.);

accounting means for registering usage information for the identified multimedia object file (Paragraphs 0057; 0061. Register usage for reporting.);

reporting means for transmitting the registered usage information to a third party when the registered usage information meets a predetermined criterion, to allow afterwards, billing for sharing of the multimedia object file in accordance with the registered usage information for the multimedia object (Paragraph 0057; 0061. Report usage for billing.).

Levy does not specifically teach of the identifying means comprising a fingerprint calculator to obtain the identifier by computing a fingerprint for at least a portion of the multimedia object file; wherein the device is to inhibit sharing of the multimedia object in response to the reporting means failing to transmit the registered usage information to the third party; and user profile maintenance means for maintaining user profile information including browsing behavior to identify a multimedia interest of the user.

Levy '2002/0052885 teaches of registering sharing of the multimedia with other devices (Paragraphs 0032-0033) and obtaining an identifier by computing a fingerprint for at least a portion of the multimedia object (Paragraphs 0046; 0111; 0114).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to obtain an identifier by computing a fingerprint for at least a portion of the multimedia object. The motivation for the suggested combination is that Levy '2002/0052885's teachings would improve Levy's teachings by allowing verification that a file is complete as suggested by Levy '2002/0052885.

Ishibashi teaches a similar system for maintaining utilization history of content, wherein a device is arranged to inhibit sharing of the multimedia object in response to the reporting means failing to

transmit information used to determine usage fee to the third party (col. 20, lines 54-58; col. 97, lines 35-50. Detect charge information is uncollected and prevent reproduction of content.).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to inhibit sharing of the multimedia object in response to the reporting means failing to transmit the information to the third party. The motivation for the suggested combination is that Ishibashi's teachings would improve the suggested system by preventing illegal reproduction of content (col. 97, lines 33-36).

Horvitz teaches of maintaining user profile information including browsing behavior to identify a multimedia interest of the user (Paragraphs 0074; 0075. Gather attribute values based on user actions and recommend multimedia content.).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to maintain user profile information including browsing behavior to identify a multimedia interest of the user. The motivation for the suggested combination is that Horvitz's teachings would improve the suggested system by enabling a user to receive recommendations using new recommendation techniques based on user habits (Paragraph 0002; 0135).

As per claim 14, Levy teaches substantially the invention as claimed including a device configured to share a multimedia object, the device comprising:

a file sharing module configured to share the multimedia object file with other devices (Paragraphs 0011; 0057. Usage of content includes copying and distributing of content.);

an accounting module configured to register usage information for the multimedia object file, based on the identifier (Paragraphs 0057; 0061. Register usage for reporting.);

a reporting module configured to transmit registered usage information to a third party based on the registered usage information meeting a predetermined criterion to allow billing for sharing of the

multimedia object file in accordance with the registered usage information (Paragraph 0057; 0061. Report usage for billing.).

Levy does not specifically teach a fingerprinting module including a fingerprint calculator configured to obtain an identifier for the multimedia object by computing a fingerprint for at least a portion of the multimedia object file; the device configured to inhibit sharing of the multimedia object file in response to the reporting means failing to transmit the registered usage information to the third party; and a user profile maintenance module configured to maintain user profile including browsing behavior of the user to identify a multimedia interested of the user.

Levy '2002/0052885 teaches of registering sharing of the multimedia with other devices (Paragraphs 0032-0033) and obtaining an identifier by computing a fingerprint for at least a portion of the multimedia object (Paragraphs 0046; 0111; 0114).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to obtain an identifier by computing a fingerprint for at least a portion of the multimedia object. The motivation for the suggested combination is that Levy '2002/0052885's teachings would improve Levy's teachings by allowing verification that a file is complete as suggested by Levy '2002/0052885.

Ishibashi teaches a similar system for maintaining utilization history of content, wherein a device is arranged to inhibit sharing of the multimedia object in response to the reporting means failing to transmit information used to determine usage fee to the third party (col. 20, lines 54-58; col. 97, lines 35-50. Detect charge information is uncollected and prevent reproduction of content.).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to inhibit sharing of the multimedia object in response to the reporting means failing to transmit the information to the third party. The motivation for the suggested combination is that

Ishibashi's teachings would improve the suggested system by preventing illegal reproduction of content (col. 97, lines 33-36).

Horvitz teaches of maintaining user profile information including browsing behavior to identify a multimedia interest of the user (Paragraphs 0074; 0075. Gather attribute values based on user actions and recommend multimedia content.).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to maintain user profile information including browsing behavior to identify a multimedia interest of the user. The motivation for the suggested combination is that Horvitz's teachings would improve the suggested system by enabling a user to receive recommendations using new recommendation techniques based on user habits (Paragraph 0002; 0135).

As per claim 8, Levy teaches the device of claim 3, in which the usage information being registered for the multimedia object file comprises duration of media content associated with the multimedia object file (Paragraph 0061. Determine amount of usage by counting watermarks embedded in video frames, e.g. 1 second interval.).

As per claim 11, Levy does not specifically teach the device of claim 3, wherein the reporting means is to transmit at least a portion of the user profile to the third party.

Horvitz teaches of transmitting a portion of the user profile to a third party (Paragraphs 0074; 0075. The backend, i.e. server, may gather attribute values.).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to transmit a portion of the user profile to a third party. The motivation for the suggested combination is that Horvitz's teachings would improve the suggested system by enabling a user

to receive recommendations using new recommendation techniques based on user habits (Paragraph 0002; 0135).

As per claim 16, Levy teaches the device of claim 14, in which the registered usage information being registered for the multimedia object comprises duration of media content associated with the multimedia object file (Paragraph 0061. Determine amount of usage by counting watermarks embedded in video frames, e.g. 1 second interval.).

Claims 7 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levy, Levy '2002/0052885, Ishibashi, and Horvitz, in view of Sako et al. US Patent #7,062,467 (Sako hereinafter)

As per claim 7, Levy does not specifically the device of claim 3, in which the usage information being registered for the multimedia object file comprises a number of times the multimedia object file is being shared.

Sako teaches of registering a number of times content is shared (Abstract; col.1, lines 60-67; claim 21).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings for the usage information as taught by the suggested system to comprise a number of times content is being shared as taught by Sako. The motivation for the suggested combination is that Sako's teachings would improve the suggested system by providing a specific basis for billing and allowing billing of content based on distribution of content.

As per claim 15, Levy des not specially teach the device of claim 14, wherein the registered usage information includes a number of times the multimedia object file has been shared.

Sako teaches of registering a number of times content is shared (Abstract; col.1, lines 60-67; claim 21).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings for the usage information as taught by the suggested system to comprise a number of times content is being shared as taught by Sako. The motivation for the suggested combination is that Sako's teachings would improve the suggested system by providing a specific basis for billing and allowing billing of content based on distribution of content.

Claims 9 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levy, Levy '2002/0052885, Ishibashi, and Horvitz, in view of Kutaragi et al. US Patent #7,275,261 (Kutaragi hereinafter)

As per claim 9, Levy teaches of sharing multimedia object but does not specifically teach the device of claim 3 in which the predetermined criterion comprises a predetermined number of times the multimedia object file has been shared.

Kutaragi teaches of monitoring utilizing condition of content, wherein utilization history is transmitted when a number of times of utilizing content exceed a predetermined number (claim 4).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings for the predetermined criteria to comprise a predetermined number of times the multimedia object is utilized. The motivation for the suggested combination is that Kutaragi's teachings would improve the suggested system by enabling automatically reporting of usage information for billing for the usage of content as suggested by Kutaragi.

As per claim 17, Levy teaches of sharing multimedia object but does not specifically teach the device of claim 14 in which the predetermined criterion comprises a predetermined number of times the multimedia object file has been shared.

Kutaragi teaches of monitoring utilizing condition of content, wherein utilization history is transmitted when a number of times of utilizing content exceed a predetermined number (claim 4).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings for the predetermined criteria to comprise a predetermined number of times the multimedia object is utilized. The motivation for the suggested combination is that Kutaragi's teachings would improve the suggested system by enabling automatically reporting of usage information for billing for the usage of content as suggested by Kutaragi.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua Joo whose telephone number is 571 272-3966. The examiner can normally be reached on Monday to Friday 7 to 4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Flynn can be reached on 571 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/J. J./
Examiner, Art Unit 2454

/NATHAN FLYNN/

Supervisory Patent Examiner, Art Unit 2454